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09/777,304	02/06/2001	Casey S. Pontenzone	7957-055	5699

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

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DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/777,304

Applicant(s)

PONTENZONE ET AL.

Examiner

Quang N. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Detail Action***

1. This Office Action is in response to the application SN 09/777,304 filed on 02/06/2001. Claims 1-25 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks et al. (US 2001/0053944 A1), herein after referred as Marks.**

4. As to claims 1-2, Marks teaches an audio Internet navigation system comprising:  
a station and playlist module for managing the content delivered by one or more stations over the network (*i.e., a network of associated stations*), the type of content that

maybe delivered by each of the stations being specified by a playlist for that station, wherein at least one of said stations includes two or more playlists (*the station's main/default playlist "Top Channel" and one or more distinct sidechannels of personalized programming*) and only one of said two or more playlists specifies the content that may be delivered by that station at any one time (Abstract, paragraphs [0017], [0036] and [0044-0046]).

5. As to claim 3, Marks teaches the system of claim 1, wherein the network is the Internet (paragraph [0017]).

6. As to claim 4, Marks teaches the system of claim 1, wherein the content is audio-based and each playlist includes a number of songs that maybe delivered by the station associated with that playlist (paragraphs [0012 and 0073]).

7. As to claim 6, Marks teaches the system of claim 1, wherein the content is multimedia-based and each playlist includes a number of music videos that may be delivered by the station associated with that playlist (paragraph [0030]).

8. As to claims 7-8, Marks teaches the system of claim 1, wherein the system further comprises a promotions (advertisement) module for managing promotional (advertising) content to be included in the playlists (paragraphs [0039 and 0094]).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks, in view of Rouchon (US 2001/0025259 A1).**

11 As to claim 5, Marks teaches the system of claim 1, but does not explicitly teach the playlist contains at least one combination of songs that are in compliance with a set of licensing rules.

In a related art, Rouchon teaches a system and method for distributing digital music to listeners over a public computer network, wherein the radio station that agrees to air or distribute the songs will sign an exclusive contract with the artists mentioning information such as price of the song, percentage of profit share between the artist, radio station, and copyright restriction (*i.e., songs are in compliance with a set of licensing rules*) (Rouchon, paragraphs [0015] and [0051]).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Marks and Rouchon to

include a playlist validation module for verifying that a playlist contains at least one combination of songs that are in compliance with a set of licensing rules as mentioning in the contract since such methods were conventionally employed in the art to promote a music band awareness and popularity, to allocate payment of royalties or license fees to owners of rights in the audio files, and also to secure publishing and distribution rights without violate the copyright or phonograph restrictions.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**13. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Foladare et al. (5,819,160), herein after referred as Foladare.**

14. As to claim 9, Foladare teaches a system for managing the delivery of content over a network comprising: a database (*i.e.*, *the subscription content database 18*) for storing information describing the content able to be delivered by one or more stations over the network, and a request module for allowing a user of the system to request

new content, not described by information stored in the database (*i.e., the user may key-in or enter for the playlist a new keyword that is not already present in the subscription content database 18*) (Foladare, C4: L21-38 and C6: L2-4).

15. As to claim 10, Foladare teaches the system of claim 9, wherein the request module further allows user to track the status of a request for new content (*via the playlist identification "ID" code*) (Foladare, C5:L51 – C6:L56).

16. As to claims 11-12, Foladare teaches the system of claim 9, wherein the content is at least partly audio-based, the information stored in the database describes songs that maybe searched by a song name, artist name, or recording name (*the subscription content database contains a large number of music selections organized and cross referenced by selection name, performing artist and music genre so that each selection maybe readily located by the subscriber*) (Foladare, C2: L39-54 and C4: L21-38).

15. As to claim 13, Foladare teaches the system of claim 11, wherein the system enables a song described by a user's new content request to be automatically added to a playlist (Foladare, C5: L51-63 and C6:L66 – C7:L7).

16. As to claim 14, Foladare teaches the system of claim 9, wherein the network is the Internet (C4: L4-20).

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17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**18. Claims 15-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Drosset et al. (US 6,662,231), herein after referred as Drosset.**

19. As to claim 15, Drosset teaches a system and method for providing audio service to a client through a communication network, wherein a user module for managing the operation access granted to users of the system, the user module classifying users into at least two categories including a first user category (*paying membership*) having full access privileges to the system and a second user category (*non-paying membership*) having less than full access privileges to the system (Drosset, C13: L53-62).



20. As to claim 16, Drosset teaches the system of claim 15, wherein the user module permits a user in the first user category to create a profile (*i.e., a playlist*) for a user in the second category (*i.e., the user/subscriber may maintain and modify customized playlists through the server and send playlists to other users*) and does not permit a user in the second user category to create a profile for a user in the first category (*i.e., non-paying member or non-registered user will not be allowed to have full access as paying member but to search for music and transact purchases and will be only allowed to listen to promotional albums*) (Drosset, C2: L50-52 and C10: L50-58).

21. As to claim 17, Drosset teaches the system of claim 15 further comprising a user activity log module for maintaining a record of user management activities (*e.g., User stated genre preference at registration, History of music listening/management access, etc.*) carried out by all users of the system (Drosset, C20: L43-52).

22. As to claim 18, Drosset teaches the system of claim 15, wherein the content is categorized into supergenre and genre categories (*at step 556, the user selections are categorized*) and wherein the user module permits a user in the first user category, but does not permit a user in the second user category, to create a supergenre or a genre category (*non-paying member or non-registered user will not be allowed to have full access as paying member but to search for music and transact purchases and will be only allowed to listen to promotional albums*) (Drosset, C9: L33-40, C13: L53-62 and C16: L10-16).

23. As to claim 19, Drosset teaches the system of claim 15, wherein the network is the Internet (*i.e., the public IP network 70 of Fig. 1*) (Drosset, Fig. 1).

24. As to claim 20, Drosset teaches a system for managing the delivery of song content over a network comprising: a content categorization module allowing a user to assign song content, based on an artist of each song, into supergenre and genre categories, each genre category being assigned to only one supergenre category and each artist being assignable to any number of genres (*user selections are categorized based on genre, artist, era or similar data, etc.*); and a station module for managing the content delivery by one or more stations over the network; wherein each station is also assignable to any number of genres (Drosset, C9: L33-36 and C12: L30-57).

25. Claim 21 is a corresponding system claim of claim 19; therefore, it is rejected under the same rationale.

26. As to claims 22-23, Drosset teaches a system for managing the delivery of song content over a network comprising: a reporting module for compiling data based on the content broadcast by each other the one or more stations including data relating to the popularity of specific content (*such as data relating to the artists or recordings of the songs*) with listeners of the stations (*i.e., the system may also permit users to rate the*

*music currently being heard by the listener and the rating data collected and provided to the record companies and others interested in such data) (Drosset, C13:L65 – C14:L2).*

27. Claims 24-25 are corresponding system claims of claims 20-21; therefore, they are rejected under the same rationale.

28. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

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29. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen  
Examiner

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER